

***Remarks***

Reconsideration of this Application is respectfully requested.

Claims 2-5, 9 and 10 are pending in the application. Claim 2-5 have been allowed. Claim 9 has been rejected and claim 10 has been objected to. Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Rejections under 35 U.S.C. § 102***

The Examiner has maintained the rejection of claim 9 under 35 U.S.C. § 102(b) as allegedly anticipated by Kim *et al.*, *J. Neurobiology* 17: S155 (1996). (Paper No. 32, page 2.) Specifically, the Examiner has stated that:

Applicant states they spoke to one of the event coordinators to establish the date the abstract book was made available. However, a letter signed by the event coordinator would be required to establish independent verification of the meeting book availability. The arguments of counsel cannot take the place of evidence in the record.

(*Id.*)

According to section 706.02(a) of the MPEP, "[t]he Examiner must determine the issue or publication date of the reference so that a proper comparison between the application and reference dates can be made." (Emphasis added.) The Examiner has offered no information regarding the publication date of Kim *et al.*, except the citation. According to the cover page of the issue of the *Journal of Neurobiology* in which the abstract appears, the publication date of the issue was August 14, 1996 and the conference was held outside the U.S. in Osaka, Japan on July 24-26, 1996. Both dates are less than one year before the

filing date of the provisional application to which this application claims priority, April 24, 1997. Thus, the Examiner has not met his burden of establishing that the reference is available under 35 U.S.C. § 102(b).

It is not Applicants' burden to establish that this abstract did not publish before the critical date. However, to expedite prosecution, Applicants have provided herein a copy of an e-mail message from Dr. Khalid Iqbal, who was the Chairman of the Scientific Program Committee of the Fifth International Conference on Alzheimer's Disease & Related Disorders, held in Osaka, Japan, July 24-29, 1996.<sup>1</sup> (Exhibit A.) In the e-mail, Dr. Iqbal confirms that the abstracts of the conference were distributed to the conferees at the meeting and not prior to arrival at the conference. As such, it does not appear that Kim *et al.* was publicly available before July 24, 1996. Because the instant application claims priority to a provisional application which was filed on April 24, 1997, it has not been established that Kim *et al.* was published "more than one year prior to the date of the application for patent." 35 U.S.C. § 102(b). Accordingly, Kim *et al.* is not available as prior art under 35 U.S.C. § 102(b). In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

#### ***Claim Objection***

The Examiner has objected to claim 10 as allegedly dependent on a rejected claim. (Paper No. 32, page 2.) In view of the above, Applicants submit that the objection to claim

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<sup>1</sup> Dr. Iqbal is a not an inventor or assignee and has no interest in this patent application.

10 is rendered moot. Applicants, therefore, respectfully request that the Examiner reconsider and withdraw the objection.

### ***Conclusion***

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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**From:** "Dr.Khalid Iqbal" <iqbalk@worldnet.att.net>  
**To:** "Peter Choi" <PChoi@skgf.com>  
**Date:** 6/6/03 4:03PM  
**Subject:** Re: Fifth Annual Alzheimer's Conference

As a Chairman of the Scientific Program Committee of the Fifth International Conference on Alzheimer's Disease & Related Disorders, held in Osaka, Japan, July 24-29, 1996, I confirm that the abstracts of the Conference were distributed to the conferees at the meeting and not prior to arrival at the Conference.

Khalid Iqbal

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PLEASE CONFIRM RECEIPT OF THIS MESSAGE

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----- Original Message -----

From: Peter Choi  
To: iqbalk@worldnet.att.net  
Sent: Thursday, June 05, 2003 4:36 PM  
Subject: Fifth Annual Alzheimer's Conference

Dear Dr. Iqbal:

Could you please confirm that you were responsible for planning the Fifth Annual Alzheimer's Conference held in Osaka, Japan on July 24-26, 1996 and that copies of the conference abstracts WERE NOT distributed to the participants of the conference prior to their arrival at the conference? As I have mentioned to you, we need this information for a patent matter with the United States Patent and Trademark Office. Your assistance is greatly appreciated.

Thank you,  
Peter